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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,254	09/15/2003	Scott E. Hall		5234

7590 03/02/2004

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EXAMINER

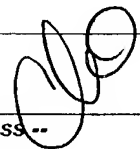
WALCZAK, DAVID J

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/662,254	Applicant(s) HALL ET AL.	
	Examiner David J. Walczak	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The continuing data on page 1 needs to be updated, i.e., Serial No. 09/993,122 is now U.S. Patent No. 6,644,878. Appropriate correction is required.

Double Patenting

Claim 3 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,644,878. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,644,878. Although the conflicting claims are not identical, they are not patentably distinct from each other because (In regard to claims 1 and 5) the pending claims are

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merely broader than the patented claims. Accordingly, the patented claim anticipates the pending claims and anticipation is the epitome of obviousness. In regard to claim 2, although the patented claims are silent as the location of the pump member, it is the Examiner's position that the location of the pump member within the power toothbrush is merely a matter of design choice, i.e. the pump member can be positioned at any suitable location within the toothbrush without effecting the overall operation of the device.

Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 6, 8 and 11 of U.S. Patent No. 6,402,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is that the pending claims (in the case of claims 1-4) define a specific reservoir volume (4 mls.) and are silent as to the structure of the power toothbrush handle in the preamble while the patented claims do not define a specific volume of the reservoir and include specifics of the power toothbrush handle in the preamble (the handle being removable and including a power unit therein). However, as claim 11 defines a "one unit of use" size, and the specification in the '410 patent suggests that this size is approximately 4 mls. (column 7, line 65), it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the size of the reservoir can be sized to be approximately 4 mls. in order to provide the user with an adequate amount of fluid for one use. With respect to the pending claims being silent as to the structure of the power toothbrush handle defined in the preamble, it is noted that the specifically

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defined structure in the preamble (the handle being removable and having a power unit therein) is not considered to be part of the claimed combination. In any event, the Examiner takes official notice that power toothbrushes are commonly equipped with removable handles having the power units therein in order to provide a power toothbrush in which the power unit is conveniently positioned and accessible.

Accordingly, it is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the power toothbrush can include a removable handle portion having the power unit therein in order to provide a power toothbrush in which the power unit is conveniently positioned and accessible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliani et al. (hereinafter Giuliani). In regard to claims 1 and 5, Giuliani discloses a fluid delivery system for a power toothbrush comprised of a fluid reservoir 30 located within the toothbrush, a pump member and associated fluid line 44 for moving fluid from the reservoir to the brush head and a dispensing member 43 located in the brush head part and connected to the fluid line to permit the fluid to flow to the bristles. Although the Giuliani reference is silent as to the size of the reservoir, it is the Examiner's position

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that it would have been obvious to one of ordinary skill in the art at the time the invention was made that the reservoir can be designed to have any suitable volume, including the claimed volume, without effecting the overall operation of the device. Further, viewing Figure 1, the dimensions of the reservoir appear to be relatively small and it appears as though a volume of 4mls. is well within the range of obvious sizes for the reservoir. In regard to claim 2, the pump member is located in the brushhead, i.e., viewing Figure 1, the "brushhead" is considered to enclose the reservoir and electronics portion 14 and therefore would also enclose the pump.


Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliani in view of English et al. (hereinafter English). Although the Giuliani reference does not include a valve which extends into the bristles, attention is directed to the English reference, which discloses another toothbrush having a dispensing member wherein such a valve 60 is present in order to dispense the toothpaste approximate to the tips of the bristles as well as prevent backflow of the toothpaste. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such a valve onto the Giuliani device in order to dispense the toothpaste approximate to the tips of the bristles as well as prevent backflow of the toothpaste.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 703-308-0608. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg L. Huson can be reached on 703-308-2580. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak
Primary Examiner
Art Unit 3751

DJW
2/28/04